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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/808,892

03/25/2004

Jeffrey D. Ollis

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GENERAL INSTRUMENT CORPORATION
101 Tournament Drive
Horsham, PA 19044

EXAMINER

MANCHO, RONNIE M

ART UNIT	PAPER NUMBER
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3663

MAIL DATE	DELIVERY MODE
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11/16/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/808,892

Applicant(s)

OLLIS ET AL.

Examiner

Ronnie Mancho

Art Unit

3663

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 August 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-5 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☒ Claim(s) 1-5 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. In view of the response filed on 8/15/07, PROSECUTION IS HEREBY REOPENED set forth below.

To avoid abandonment of the application, appellant must exercise one of the following two options:

(1) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply under 37 CFR 1.113 (if this Office action is final); or,

(2) initiate a new appeal by filing a notice of appeal under 37 CFR 41.31 followed by an appeal brief under 37 CFR 41.37. The previously paid notice of appeal fee and appeal brief fee can be applied to the new appeal. If, however, the appeal fees set forth in 37 CFR 41.20 have been increased since they were previously paid, then appellant must pay the difference between the increased fees and the amount previously paid.

A Supervisory Patent Examiner (SPE) has approved of reopening prosecution by signing below:

/Jack W. Keith/
SPE 3663

Claim Rejections - 35 USC § 112

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 1-5 rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The limitation, "*extracting* anomaly information from said recorded portion *using voice recognition*" is new matter because the original invention does not disclose the limitation.

The rest of the claims are rejected for depending on a rejected base claim.

4. Claims 1-5 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

Claim 1, recites "*extracting* anomaly information *from said recorded portion using voice recognition*". The limitation is not enabled.

Applicant's original specification, page 9, section 0024 disclose a unit SRE 106 that records predefined TBR signals (Traditional Broadcast Radio signals) for use in anomaly information extraction. It is further disclosed that SRE 106 has speech (voice) recognition abilities. And further that an audio capture memory 104 stores TBR signals recorded by SRE 106. Section 0025 discloses that the SRE 106 constantly monitors TBR signals via the audio primary band tuner 102 for a Record Trigger, such as voice recognition, signaling tone, or pre-defined time.

It is noted that after information has been recorded on a random access memory, hard drive, etc the recorded information is no longer voice or speech. The recorded information is recorded as ones (111111111) and zeros (00000000).

Therefore the limitation, "*extracting anomaly information from said recorded portion using voice recognition*" is not enabled because the recorded portion is no longer voice and thus cannot be extracted using voice as recited in applicant's disclosure. Further, applicant does not disclose a method for extraction of recorded data especially using voice recognition.

The rest of the claims are rejected for depending on a rejected base claim.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

7. Claims 1-5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Logan et al (2003/0163823) in view of Simonds et al (2004/0093154).

Regarding claim 1, Logan et al (abstract, figs. 1&2, sec. 0011-0013) disclose a system for dynamic alternative geographic route plotting using global positional satellite data (sec. 0211, 0213) said system comprising:

an audio tuner 101 (figs. 1, 2; sec. 0011-0013) said audio tuner tuning frequencies for reception of radio broadcast signals;

a selection recognition engine (DSP 103, sec. 0012) coupled to said audio tuner 101 (sec. 0012), said selection recognition engine 103 monitoring said radio broadcast signals (sec. 0012-0013) for pre-defined recording triggers (news, weather broadcast, traffic, sports, sec. 0048, 0078, 0079) and selectively recording portions of a radio broadcast signal, said selection recognition engine extracting anomaly information from said recorded portions using voice recognition (0078, 0115); and

a global positional satellite device (GPS, sec. 0202-0211, 0213), said global positional satellite device receiving said anomaly information.

Logan did not disclose generating an alternative route in response to anomaly information. However, Simonds teaches of a global positional satellite device 42 (GPS, fig. 1), said global positional satellite 42 device receiving anomaly information (weather, traffic, road construction, etc, sec. 0042) and generating at least one alternative route in response to said anomaly information (sec. 0116).

Therefore, it would have been obvious to one of ordinary skill in the art to modify Logan as taught by Simonds for the purposes of avoiding roads with anomaly information.

Regarding claim 2, Logan et al (abstract, figs. 1&2, sec. 0011-0013) disclose the system of claim 1 further comprising an audio capture memory (109, 107, fig. 1; abstract; sec. 0011,

0012) coupled to said selection recognition engine, said audio capture memory storing recorded portions of said radio broadcast signal.

Regarding claim 3, Logan et al (abstract, figs. 1&2, sec. 0011-0013) disclose the system of claim 2, wherein said audio capture memory comprises at least one of random access memory, flash memory, a hard drive, optical drive, and optical-magnetic drive (sec. 0012).

Regarding claim 4, Logan et al (abstract, figs. 1&2, sec. 0011-0013) disclose the system of claim 1 wherein said radio broadcast signal comprises a primary band signal (fig. 2, sec. 0016).

Regarding claim 5, Logan et al (abstract, figs. 1&2, sec. 0011-0013) disclose the system of claim 1 further comprising a display 115 (sec. 0013).

MPEP 2114

The statement of intended use or field of use, "tuning frequencies for", "monitoring radio broadcast signals for", "recording/storing portions of", "extracting/receiving anomaly information from", "using voice recognition", etc clauses are essentially method limitation or statement of intended or desired use. Thus, the claim as well as other statements of intended use do not serve to patentably distinguish the claimed structure over that of the reference. See MPEP § 2114 which states:

A claim containing a "recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from the prior art apparatus" if the prior art apparatus teaches all the structural limitations of the claim. Claims directed to apparatus must be distinguished from the prior art in terms of structure rather than functions. Apparatus claims cover what a device is not what a device does. As set forth in

MPEP § 2115, a recitation in a claim to the material or article worked upon does not serve to limit an apparatus claim.

Response to Arguments

8. Applicant's arguments with respect to claims 1-5 have been considered but are moot in view of the new ground(s) of rejection.

Communication

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ronnie Mancho whose telephone number is 571-272-6984. The examiner can normally be reached on Mon-Thurs: 9-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jack Keith can be reached on 571-272-6878. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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Ronnie Mancho
Examiner
Art Unit 3663

11/10/2007

/Jack W. Keith/
SPE 3663